90-1759

SUPREME COURT, U.S.
FILED
MAY 13 1991
OFFICE OF THE CLERK

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1990

DAVID M. GESHWIND,

Petitioner,

v.

EDWARD GARRICK, Individually, EDWARD GARRICK PRODUCTIONS, INC., The SCIENCE MUSEUM OF MINNESOTA, and The ASSOCIATION FOR COMPUTING MACHINERY,

Respondents.

EDWARD GARRICK PRODUCTIONS, INC.,

Third Party Plaintiff,

v.

JUDSON ROSEBUSH and DIGITAL EFFECTS, INC.,

Third Party Defendants.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

David M. Geshwind, Pro Se
c/o Anne C. Avellone, Esq.
60 West 66th Street
New York, New York 10023
(212) 787-1275

92

QUESTIONS PRESENTED FOR REVIEW

1. Whether the court incorrectly determined the ownership and authorship of a copyrighted work by failing to apply the "work for hire" test set forth in Community for Creative Non-Violence v. Reid, 490 U.S. 730, 109 S.Ct 2166, 104 L.Ed 2d 811 (1989).

2. Whether petitioner was denied a fair trial by the action of the district court in permitting to be raised at trial -- for the first time -- a defense which was contrary to contentions of law and fact specified by the defendants and third-party defendants in their pleadings and pre-trial order, and which defense formed substantially the entire basis for the district court's decision.

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED FOR REVIEW i

TABLE OF AUTHORITIES iii

I. OPINIONS BELOW 1

II. JURISDICTIONAL STATEMENT 2

III. RELEVANT STATUTES 3

IV. STATEMENT OF THE CASE 5

A. Facts Material to the Questions Presented 5

1. Production of Japan Fly-By . . 5

2. Omnimax Meeting at 1983 SIGGRAPH 10

3. Production of Rollerocaster . 11

4. Omnimax Exhibition at 1984 SIGGRAPH 12

5. Attempts to Resolve Controversy 13

B. Basis of Federal Jurisdiction in Court of First Instance 14

V. ARGUMENT 16

A. District Court Erred in Failing to Apply CCNV v. Reid 16

Page

B. The Court Erred in Failing to Limit Defendants to the Pre-Trial Order 25

VI. CONCLUSION 34

APPENDIX . . . . . App. 1

1. Decision of the U.S. Court of Appeals for the Second Circuit. Entered: January 11, 1991 . . App. 1

2. Decision of the U.S. District Court for the Southern District of New York. Entered April 30, 1990 . . . App. 5

3. Decision of the U.S. District Court for the Southern District of New York, Vacating in prior decision in part. Entered: June 16, 1990 . . . App. 41

2. Decision of the U.S. Court of Appeals for the Second Circuit Denying Petition for Rehearing. Entered: February 11, 1991 . App. 52

TABLE OF AUTHORITIES

Page

Community for Creative Non-Violence v. Reid, 490 U.S. 730, 109 S.Ct 2166, 104 L.Ed 2d 811 (1989) . . . . . i, 16, 20, 24

Easter Seal Society v. Playboy Enterprises 815 F.2d 323 (5 Cir. 1987). 20

Flannery v. Carroll, 676 F. 2d 126 (5 Cir. 1982). 25

Geshwind v. Garrick, et al., 734 F. Supp. 644, vacated in part 738 F. Supp. 792, (S.D.N.Y. 1990). 1, 18, 32

United States v. Hougham, 364 U.S. 310 (1960). 25

17 U.S.C. Sec. 101. . . . . 3, 16, 22

28 U.S.C. Sec. 1338(a). 2, 15

Fed. Rules Civ. Proc. Rule 16, 28 U.S.C.A. 4

Restatement of Agency 2d: Section 216. 19

I. OPINIONS BELOW

The opinion of the Court of Appeals (Appendix, infra, App. 1-4) is not officially reported, nor is its denial of the petition for reconsideration (App. 52-53). The decision of the district court is reported at 734 F. Supp. 644, (App. 5-40) which decision was vacated in part at 738 F. Supp. 792 (S.D.N.Y. 1990) (App. 41-51). A motion pursuant to Rule 60(b) of the Federal Rules of Civil Procedure based upon new evidence discovered subsequent to the initial decision of the Court of Appeals is currently pending before the district court.

II. JURISDICTIONAL STATEMENT

The decision of the Court of Appeals for the Second Circuit was entered on January 25, 1991. A petition for rehearing was filed. The decision of the Court of Appeals denying the petition was entered on February 11, 1991. Jurisdiction of this Court to review this case on a petition for certiorari rests upon 28 U.S.C. Sec. 1338(a).

III. RELEVANT STATUTES

The statutes relevant to the issues herein, in pertinent part, are:

A "work made for hire" is --

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audio-visual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer materal for a test, or an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

17 U.S.C. 101

and

> The court shall make an order which recites the action taken at the conference, the amendments allowed to the pleadings, and the agreements made by the parties as to any of the matters considered, and which limits the issues at trial to those not disposed of by admissions or agreements of counsel; and such order when entered controls the subsequent course of the action unless modified at the trial to prevent manifest injustice.

Fed.Rules Civ.Proc. Rule 16, 28 U.S.C.A.

IV. STATEMENT OF THE CASE

A. Facts Material to the Questions Presented

1. Production of Japan Fly-By

By 1982, David M. Geshwind was a well known and experienced programmer, artist and producer of computer graphics and animation.

In early 1982, Geshwind was approached by Mr. Robert Ruenitz, who was familiar with Geshwind's work, regarding a project to produce a computer animated segment to be used in a Japanese television commercial for the Tohoku Electric Power Company. Ruenitz contacted several producers and eventually commissioned Geshwind to produce the piece. Ruenitz's counterpart in Japan was Mr. Sumitani. Also involved, was Mr. Tomoe who worked for Meitsu (the advertizing agency between Ruenitz's company and Tohoku, the eventual client) who drew a storyboard

depicting the general concept for the finished commercial which was to include the animated segment.

Ruenitz commissioned Geshwind and contracted with him to produce the animated segment and provided to Geshwind a copy of Tomoe's storyboard as well as a commercially available map of Japan.

Geshwind considered several computer facilities and eventually chose Digital Effects, Inc. ("DEI") as the facility where he would produce the animated segment, which was known internally at DEI as Japan Power and later, generally, as "Japan Fly-By".

Geshwind contracted with Judson Rosebush, president of DEI, for DEI to provide facilities and services in connection with Geshwind's production of the Japan Fly-By segment. During approximately five weeks in January and February of 1982, a fifteen second piece of film was

produced and delivered, via Geshwind and Ruenitz, to Tohoku, for incorporation into their larger television commercial.

Prior to production, the only written memorialization of the agreement between Geshwind and DEI was a DEI quotation form which was executed by Judson Rosebush, and which included a description of the animation written by Geshwind. This DEI quotation form provided that "Purchaser assumes liability for patent and copyright infringment when goods are made to Purchaser's specification" (Trial Exhibit 94).

Donald Leich, a DEI employee, was assigned to work with Geshwind and operate the DEI equipment during the production. Geshwind provided to Leich the storyboard and map given to him by Ruenitz. Geshwind also provided a self-conceived, hand-drawn contour map, depicting the ficticious environment

within which the animation was to take place. This map also indicated, by a curved red line, a path through the environment which was to be followed by the virtual 'camera point of view' and which, therefore, specified the action or choreography of the animation. A pair of 'light tubes' were also to follow this same path, preceeding the camera.

As per Geshwind's instructions, the maps and the red line were traced into the DEI computer as a basis for the databases and animation choreography. Geshwind provided other artistic directions and made choices as to colors, spacing, line density, etc. Geshwind also provided technical directions, even going so far, in one case, as to provide Leich with mathematical formulae describing a relationship between camera position and point of view. During the production period, Leich operated DEI's computers to

produce test images and sequences on an almost daily basis. These were reviewed by Geshwind and his instructions as to changes were communicated to Leich either in person or in writing.[1]

Before and during the production, Ruenitz operated in an adminsitrative capacity only and provided no creative or technical input. Tomoe visited with Geshwind once, briefly, to review a motion test and approve continuation of the project without further comment. Sumitani remained in Japan and had no direct contact with Geshwind.

1/ Every fact contained in this paragraph was testified to by Leich himself, the defense's own witness, and a witness whom the district court chose to characterize as credible.

2. Omnimax Meeting at 1983 SIGGRAPH

In July, 1983, Geshwind attended the annual conference of the ACM/SIGGRAPH (the Special Interest Group in Graphics of the Association of Computing Machinery, an organization of computer scientists, computer artists, manufacturers and others interested in computer graphics and animation). There, he attended an organizational meeting for a project whose goal would be the production of a compilation of computer animated segments filmed in the Omnimax format (ultra-large film frame, with an image distorted for projection on a domed screen). Geshwind had been invited to attend by Nelson Max, a computer animator who had experience in this format and whose idea the project was. Max opened the meeting. Among others, he introduced Edward Garrick who eventually became the producer of the film, eventually called

"The Magic Egg".

Geshwind also attended a follow-up meeting, later in the conference, which was also attended by Judson Rosebush, president of DEI. At that meeting, it was discussed that Geshwind and DEI might collaborate on adapting Japan Fly-By to the Omnimax format for inclusion in the compilation.

3. Production of Rollercoaster

Both Geshwind and Rosebush followed up with letters to Garrick offering to collaborate and contribute the segment. Both letters indicated that Geshwind was to be involved as producer of the adaptation.

Geshwind repeatedly contacted Garrick, by letter and phone message, regarding Geshwind's contribution to the project, however Garrick did not respond. Garrick's co-producer did meet with DEI and arranged for DEI to utilize the

"database and initial choreography" (quotation taken from Trial Exhibit 30, Garrick's 1/26/84 Production Report) from Japan Fly-By to adapt it to the Omnimax format, as a segment eventually entitled "Rollerocaster". This was done with neither Geshwind's knowledge nor his permission.

4. Omnimax Exhibition at 1984 SIGGRAPH

Geshwind attended the 1984 SIGGRAPH Conference where he first became aware that Japan Fly-by had been adapted for inclusion in The Magic Egg. The film was being exhibited on the domed ceiling of the William L. McKnight theatre of the Science Museum of Minnesota (which became a financier and co-producer of the film). Special VIP and press screenings were held, as well as numerous screenings, throughout the week-long conference, for the conference's approximately 25,000 general attendees. The credits, both on

The Magic Egg and in a brochure distributed to viewers, attributed the adapted work Rollerocaster to DEI and failed to credit Geshwind in any way.

5. Attempts to Resolve Controversy

At the conference Geshwind spoke to Garrick about the situation and Garrick provided Geshwind with the name of his attorney. Geshwind's attorney contacted Garrick's attorney in an attempt to license Garrick, the Science Museum and ACM/SIGGRAPH to make use of the adaption of Geshwind's work, with Geshwind treated on a par with other contributors. This attempt was unsuccessful. An agreement had alreeady been worked out with DEI regarding credits for Rollercoaster which re-named it as "Japan Fly-By" and which credited Geshwind as the 'Creator' of the segment and credited DEI as the facility which computed the Omnimax format adaption.

After Garrick refused an offer by Geshwind regarding the license, rather than negotiate further, Garrick instituted a lawsuit against Geshwind in California State Court for more than $500,000. The lawsuit was quashed due to lack of jurisdiction.

Subsequently, Geshwind instituted the current action for copyright infringment, unfair competition and tortious interference with business in the Southern District of New York. The claims raised by Garrick in his California action were not interposed as affirmative defenses or counter-claims in the instant action.

B. Basis of Federal Jurisdiction in Court of First Instance

The jurisdiction of the court of first instance in this matter, the United States District Court for the Southern District of New York rests upon

28 U.S.C. Sec. 1338(a). Personal jurisdiction over the defendants rests on the basis that defendant Association for Computing Machinery is located in the State of New York.

V. ARGUMENT

A. District Court Erred in Failing to Apply CCNV v. Reid

In Community for Creative Non Violence v. Reid, 490 U.S. 730, 109 S.Ct 2166, 104 L.Ed 2d 811 (1989) the Supreme Court interpretered 17 U.S.C. 101 of the Copyright Law, which provides that a work for hire is "(1) a work prepared by an employee within the scope of his or her employment;" and, in doing so, established the manner in which the ownership of a copyrighted work was to be determined if the work was performed by someone who was not a formal employee of the person for whom the work was being done.

The Court set forth a two part test. It required first that a determination be made as to whether, under the common law principles of agency, the work was done within the scope of employment. If the answer to that question was yes, then

authorship and ownership of the work vested in the hiring party.

Only if the answer to that question was no, should a determination be made as to authorship based upon the artistic contribution by the parties to the work.

In the case presented here, the district court (and subsequently the Court of Appeals) neglected to address the first issue: whether the work was done within the scope of the employment of the third party defendant, Digital Effects, Inc. ("DEI") by the plaintiff-petitioner, David M. Geshwind.

The district court instead solely analyzed (and petitioner contends analyzed erroneously as well, as is described briefly later in this document) the artistic contributions of the parties to the work, attributing authorship to DEI alone.

The court utterly ignored the issue

of whether DEI was acting within the scope of employment in its relationship with Geshwind. The court limited its analysis with regard to employer-employee relationships to a finding that work done by Leich, a salaried, formal employee of DEI, belonged to DEI.

The court did this even in light of a stipulated fact in the pre-trial order which was reiterated in the district court's own findings that:

> "17. Geshwind hired DEI to provide certain facilities and perform certain services in connection with the production of the Piece." (emphasis added)

Clearly the stipulation that DEI was hired, as opposed to commissioned, leads to the conclusion that DEI was working in the capacity of an "employee" of Geshwind, for the purposes of the project.

While the Court in CCNV addressed the issue of how to determine whether an individual was performing work within the scope of his employment, the Court did not specifically address the issue of how to determine whether a company or organization was acting within the scope of employment. However, the Court did instruct that the rules of agency were the appropriate body of law to apply.

An analysis of the facts of this case, under the common law of agency, leads to the conclusion that DEI was acting within the scope of employment by Geshwind.

According to the Restatement of Agency 2d:

> "A principal is often subject to liability for the unauthorized conduct of an agent with respect to matters which, under the agreement creating the relation, he has the right to direct. The range of conduct for which there may be liability is greater in the case of servants than in the case of agents

> who are not servants but, as to both classes, liability is normally based upon the fact that the tort is brought about in the course of an undertaking for the benefit, and subject to the right, of the principal to control his servant or other agent. When a master is made liable in accordance with the rule stated in this Section, the act of the servant is said to be within the scope of his employment..." Section 216. (emphasis added)

The quotation form memorializing the agreement entered into by Geshwind and DEI, clearly states:

> "Purchaser assumes liability for patent and copyright infringement when goods are made to Purchaser's specifications." (Exh-94)

There is no question in this case that Japan Fly-by was made to Mr. Geshwind's specifications and, as such, under the foregoing terms in the contract, he was responsible for actions in copyright arising from its content.

The application of the principle of respondeat superior in relation to the rules of agency was analyzed in Easter

Seal Society v. Playboy Enterprises 815 F.2d 323 (5 Cir. 1987). In that case, the court adopted a strict intrepretation of the copyright law (similar to the approach adopted by the Supreme Court in CCNV v. Reid), and stated:

> "adopting an agency-law definition of copyright-employment creates a certain moral symetry; a buyer is a statutory author if and only if he is responsible for the negligent acts of the seller. For example, a buyer will only be the author of a writing if he would liable under respondeat superior in a defamation action based on that writing." at 335.

Clearly, the agreement between DEI and Geshwind makes Geshwind responsible if the work which was created infringed the copyright of another. How then can Geshwind not have the right to control the sale, distribution and adaption of that work, and, are these not the rights of the owner of the copyright in a work?

In merely affirming the district court's decision without analysis or

opinion,[2] the Court of Appeals for the Second Circuit perpetuated the error of the district court and set an unfortunate copyright precident in the Second Circuit. Although the Court of Appeals' affirmation is unpublished and specifically designated as not to be used as precident in other cases, its existance gives added weight and credibility to the decision of the district court.

These issues effect not only Geshwind, but have enormous significance for all artists whose works fall outside the categories specified in 17 U.S.C. 101 (2) (where contracts for "works for hire" are permissible) in that their claim to authorship and rights of ownership are endangered by the participation of others

---

2/ Geshwind requested that an opinion be prepared both in his petition for reconsideration and by a subsequent letter to the Court.

in the production process.

In particular, for those artists who work in high-technology media, or who create monumental-scale works beyond their physical capabilities, the services of others or access to expensive and complex facilities are essential. And, often these services or access is obtained by hiring a company or other organization.

In the district court, Geshwind, with the level of actual creative and technical control he exerted on the project[3] was unable to establish author-

---

3/ For a discussiion of the level of Geshwind's involvement in the creation of the work, as acknowledged by defendants' own witness Leich, see Statement of Facts, supra at pp. 7-9. In addition, third-party defendant Rosebush acknowldged that Geshwind functioned as the producer and technical director for the project; and both Leich and Rosebush acknowledged that Geshwind had a higher level of expertise and more involvement in this project than their usual clients.

ship to the court's satisfaction; and, with the right to control the project, which is what is examined under agency principles, was unable to establish an employer-employee relationship to the court's satisfaction. If such a precident is allowed to stand, then the more traditional artist, when confronted with having to hire computer or other high-tech facilities will certainly fail to reach the required threshhold for ownership. This is contrary to the purpose of the work for hire provision in the new copyright law which was intended to give artists more rights and more control over their work not jeopardize their rights of authorship and ownership.

The failure of the court to follow the rules set forth in CCNV v. Reid has resulted in an injustice being done to Petitioner. If allowed to stand, it will set a precident for such injustices to be

inflicted on all artists.

B. The Court Erred in Failing to Limit Defendants to the Pre-Trial Order

Petitioner contends that the district court, in allowing the respondents (defendants) to present at trial, for the first time, a defense which was contrary to that presented by them in the pleadings and pre-trial order, unfairly prejudiced the petitioner and denied him a fair trial.

The purpose of a pre-trial order is to narrow down the issues at trial and allow the parties to prepare for the trial by being, at least roughly, aware of what the other side is going to assert as fact, and the theories and defenses that those facts are expected to prove. United States v. Hougham, 364 U.S. 310 (1960), Flannery v. Carroll, 676 F. 2d 126 (5 Cir. 1982).

In this case, questions concerning

Geshwind's ownership and authorship of Japan Fly-by were not raised, or even considered, as issues by any party -- plaintiff, defendants, or third party defendants -- until the defendants put them forth, for the first time, as a defense at trial.

The pre-trial order in this matter is 78 pages long and the only factual contention by the defendants in it, concerning the ownership of Japan Fly-by, is the following:

"2. Tohoku owns the Piece."

Since this was the defense raised by the defendants (challenging Geshwind's standing), Geshwind prepared to establish at trial that he and not his eventual client, Tohoku Electric Power Company, was the owner of Japan Fly-by, the work in question. That Tohoku was the owner of the work was the 'fact' contended by the defendants not only in the pre-trial

order but also in their motion for summary judgment, their pre-trial memorandum and pleadings.

Further, when given the opportunity to modify the pre-trial order prior to trial, the defendants submitted a modification contending that DEI was a joint author of the work, and then withdrew that modification only a few days later. This clearly indicated that they were not planning to raise this defense at trial.

In summary, the only factual matters relating to liability which were to be resolved at trial, according to the pre-trial order can be generally stated as: whether the relationship between Tohoku and Geshwind left Geshwind with exclusive rights in Japan Fly-by; and, whether Rollercoaster infringed Japan Fly-by.

The theory that DEI might be the owner of Japan Fly-by is diametrically

opposed to the defense posited by the defendants in the pre-trial order. In fact, not even DEI ever contended that it owned Japan Fly-by until trial, and then it was DEI's employees, Rosebush and Leich, asserting their ownership, rather than DEI's attorney who, in his opening statement, likened DEI's participation in the project to that of a word-processing operator.

The actions of the defendants, in first submitting an amendment regarding joint authorship to the pre-trial order (for which Geshwind would have had to prepare an argument regarding his authorship of the work vis-a-vis DEI) and then withdrawing that amendment, indicates that the defendants purposefully withheld that theory until trial, when they knew it would be impossible to obtain fact and expert witnesses or evidence to rebut Leich's testimony.

Until trial, the only burden Geshwind had to meet to establish his ownership in the copyright, was to offer into evidence a copyright certificate in his name filed within five years of the publication of the work. (Trial Exhibit 1) With the introduction of this evidence, Geshwind established a prima facie case of copyright ownership of the work. Once he had established that fact, his only burden was to overcome the 'fact', alleged by defendants in the pre-trial order, regarding his ownership of Japan Fly-by vis-a-vis Tohoku.

The only further matter that plaintiff should have had to prove during trial, was that Rollercoaster was an adaption of, or substantially similar to, Japan Fly-by.

While the court has the right to allow a party to advance a theory not in the pre-trial order to avoid manifest

injustice, the general rule is that when neither the pleadings nor the pre-trial order advance a particular theory, the party is precluded from advancing that theory at trial. F.R.C.P. 16. There is no possible rational reason that defendants can advance for not positing these 'facts' prior to the trial, other than that they did not wish Mr. Geshwind to be affored the opportunity to obtain outside evidence to discredit those theories.[4]

4/ It became obvious at trial that the court was not going to restrict the defendants to the pre-trial order, even after objections were raised by petitioner's attorney regarding this issue, and the district court itself recognized that the trial was deviating from the pre-trial order. Geshwind then attempted to introduce evidence available to him, including a videotape containing previous works of his computer animation which would have demonstrated that the techniques which Leich was claiming to have developed (without Leich having provided any evidence to establish that he had ever used them before) were, in fact, (cont.)

Under these circumstances, requiring the defendants to adhere to the pre-trial order would not have constituted a manifest injustice. Rather, a manifest injustice occurred by allowing this defense to be raised, without notice to Geshwind and without providing him an opportunity to prepare to counter it.

A major consideration regarding whether a deviation from a pre-trial order constitutes reversible error, is the importance of the theory or evidence and the amount of prejudice that resulted from the introduction of the material. In this case, the new defense was the sole basis upon which the district court made its determination of copyright ownership.

If the testimony of Mr. Leich that

(4. cont.)
developed by Geshwind prior to the Japan Fly-by project. The district court refused to allow this evidence to be presented.

was directed toward proving that he was the creator, and DEI the owner, of Japan Fly-by, were removed, at least 13 of the findings of the court (67, 70, 71, 72, 74, 76, 77, 78, 80, 81, 82, 83, and 84) and perhaps two others (68 and 73) would be eliminated. Thus, more than 2/3 of the court's findings (other than those which merely repeated facts which were stipulated to by the parties prior to trial) are tainted by this issue alone.[5]

The failure of the court to restrict the defendants, and its own considera-

---

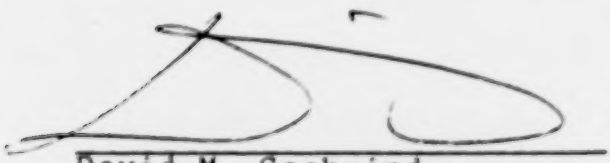
5/ The court also ignored the other evidence in the testimony, depositions, and documents generated by the defense witnesses which was against interest and which contradicted the new defense. For example, the court ignored testimony that Geshwind was the "producer" and "technical director", that Sumitani (not Leich) was the "director" of the work, or a publicity article prepared by DEI which stated that Japan Fly-By had been "designed" by Geshwind.

tion, to the facts and issues in the pre-trial order was highly prejudicial to Geshwind and substantially effected the determination of the court. As such, the court's actions constituted reversible error.

VI. CONCLUSION

For the foregoing reasons, Petitioner David M. Geshwind respectfully requests this Court grant his Petition for Certiorari.

Respectfully submitted,



David M. Geshwind,
Petitioner, Pro Se
c/o Anne C. Avellone, Esq.
60 West 66th Street
New York, New York 10023
(212) 787-1275

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

At a stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City and County of New York, on the 11th day of January, one thousand nine hundred and ninety-one.

PRESENT:

HONORABLE WILFRED FEINBERG
HONORABLE WILLIAM H. TIMBERS
HONORABLE JON O. NEWMAN

Circuit Judges

DAVID M. GESHWIND,

Plaintiff-Appellant,

- against -

EDWARD GARRICK, et al.,

Defendants-Appellees.

DOCKET NO. 90-7560

ENTERED: JANUARY 11, 1991

Appeal from the United States

District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Southern District of New York, and was argued by appellant pro se and by counsel for appellees.

UPON CONSIDERATION WHEREOF, it is hereby ordered, adjudged and decreed that the judgment of said district court is AFFIRMED.

1. Plaintiff David M. Geshwind appeals from a judgement of the United States District Court for the Southern District of New York, Judge Robert P. Patterson, Jr. Following a two-week non-jury trial, the district court, in an opinion reported at 734 F. Supp. 644, ruled against Geshwind on all of his claims, which included claims under the Copyright and Lanham Acts, and directed

that judgment be entered for defendants with costs and attorney' fees of the defendants and third-party defendents to be paid by Geshwind. Upon Geshwind's post-trial motions, the district court, in an opinion reported at 738 F. Supp. 792, refused to grant a new trial but vacated its prior award of attorneys' fees and costs.

2. Geshwind claimed that he was the creator of a computer animation entitled "Japan Fly-By," thus protecting his rights in that work under the Copyright Act. The district court, after making extensive findings of fact, rejected Geshwind's Copyright and Lanham Act claims upon concluding that third-party defendant Digital Effects, Inc., (Digital) through its employee Don Leich, was the creator of Japan Fly-By, or in the alternative, that Japan Fly-By was a joint work of Digital and Geshwind. 734

F. Supp. at 650-51. The district court then rejected Geshwind's remaining claims for malicious prosecution and abuse of process. Id. at 651-52. On appeal, Geshwind argues that the district court erred in rejecting all has claims.

3. We have considered all of Geshwind's arguments, and affirm the judgement of the district court substantially for the reasons given in its opinion reported at 734 F. Supp. 644.

WILFRED FEINBERG

WILLIAM H. TIMBERS

JON O. NEWMAN

Circuit Judges

N.B: This summary order will not be published in the Federal Reporter and should not be cited or otherwise relied upon in unrelated cases before this or any other court.

UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK

DAVID M. GESHWIND,

Plaintiff,

v.

EDWARD GARRICK, Individually, EDWARD GARRICK PRODUCTIONS, INC., The SCIENCE MUSEUM OF MINNESOTA, and The ASSOCIATION FOR COMPUTING MACHINERY,

Defendants.

EDWARD GARRICK PRODUCTIONS, INC.,

Third Party Plaintiff,

v.

JUDSON ROSEBUSH and DIGITAL EFFECTS, INC.

Third Party Defendants

FILE NO.: 85 CIV. 2136 (RPP)

ENTERED: APRIL 30, 1990

FINDINGS OF FACT, CONCLUSIONS OF LAW AND DECISION

Plaintiff David Geshwind instituted this action in 1985 against Edward Garrick individually, and Edward Garrick

Productions, Inc. (Productions), the producer of a computer animation film entitled "The Magic Egg," and against The Science Museum of Minnesota (SMM) and The Association for Computing Machinery (ACM), organizations which have exhibited The Magic Egg.

Plaintiff's suit is brought under the Copyright Act, 17 U.S.C. §501, et seq., and the Lanham Trademark Act, 15 U.S.C. §1125(a).

Defendant Productions makes third-party claims over against third party defendants Judson Rosebush and Digital Effects, Inc. (Digital) based upon an indemnity agreement. Defendant ACM also claims over against third-party defendant Digital based on an indemnity agreement.

A two-week non-jury trial was held from February 23 to March 8, 1990. This opinion constitutes the findings of fact and conclusions of law of the Court.

FINDINGS OF FACT

1. Plaintiff David Geshwind, at the times relevant to this litigation, was a producer of computer graphics animation and special effects. Geshwind from time to time used the trade name Digital Video Systems.

2. Defendant Garrick is the owner of a film production company and has been involved in the production, direction and creation of certain computer animated films.

3. Defendant and third-party plaintiff Productions is a film production company, whose president is Garrick.

4. Defendant SMM is an institution located in St. Paul, Minnesota which exhibits various works and owns and operates the William L. McKnight - 3M Omnitheater which has a domed ceiling on which are exhibited certain films.

5. Defendant and third-party plaintiff ACM is an association of individuals and corporations involved in the computer industry.

6. SIGGRAPH is ACM's Special Interest Group on Computer Graphics. Its members include engineers, architects, artists, animators and filmmakers, software and hardware developers and manufacturers, scientists, mathematicians and other professionals in the fields of computer graphics theory, design and implementation.

7. Third-party defendant Digital was at all times relevant to the events herein a corporation with facilities and services for the development and production of computer graphics animation which hires its facilities and services to others. Digital is no longer in business.

8. Third-party defendant Rosebush was for some period of time an employee

of Digital.

9. In January 1982, Geshwind entered into a written agreement (the Production Agreement) with one Robert Ruenitz of Ruenitz Associates, Inc. (Plaintiff's Exh. 13)

10. The Production Agreement provided that Geshwind would Produce for Ruenitz and his client a 15-second piece of animation (the Piece).

11. It was anticipated that the Piece would be included in a commercial being produced by a Japanese advertizing agency called Meitsu for a Japanese client called the Tohoku Electric Power Company (Tohoku). Ruenitz's contact in Japan was Michiya Sumitani.

12. The Production Agreement stated, among other things, that:

a. Geshwind would "have the right to use images from the project for purposes of demonstration or publicity."

b. The "elements developed for the project would not be used in other commercial 'projects.'"

c. "Changes to this agreement, by either party, will be affected [sic] in writing and signature of both parties."

13. The Production Agreement provided that Geshwind would produce test elements at certain milestones and that Ruenitz would approve the elements at such milestones prior to further production.

14. The Production Agreement provided that Ruenitz would make payments to Geshwind for the production of the Piece at various milestones prior to further production.

15. Ruenitz provided Geshwind with a storyboard for the commercial and certain geographical information about Japan. (Defendants' Exh. D)

16. The storyboard for the Piece was

developed and drawn by a Mr. Tomoe.

17. Geshwind hired Digtial to provide certain facilities and perform certain services in connection with the production of the Piece.

18. Geshwind negotiated for the facilities and services of Digital through Rosebush.

19. Geshwind provided Digital with, among other things, the storyboard drawn by Tomoe and topographical maps of Japan.

20. The facilities and certain services of Digital were used in the production of the Piece.

21. At various time during the production of the Piece, Geshwind was in contact with Ruenitz.

22. At a certain production milestone provided in the Production Agreement, Geshwind sent test slides to Ruenitz.

23. At a certain production

milestone provided in the Production Agreement, Geshwind showed a motion study to Tomoe.

24. In approximately March 1982, the final film negative of the Piece, eventually entitled "Japan Fly-By," was delivered to Ruenitz. It was anticipated that the piece would be delivered to a Japanese advertising agency (Meitsu).

25. At some point in 1982, Digital included Japan Fly-By (under the name "Japan Power") in a demonstration or sampler reel entitled "Digital Effects Sample '82" (Digital's 1982 Sampler).

26. Digital's 1982 Sampler was shown at the Film and Video Show of the 1982 SIGGRAPH Conference.

27. Geshwind's demonstration or sampler reel, containing Japan Fly-By, was also shown at the 1982 SIGGRAPH Conference.

28. AMC/SIGGRAPH collects and

compiles various computer graphic works and sells such compilations as issues of the SIGGRAPH Video Review.

29. Individuals and organizations submit computer graphic work to ACM/SIGGRAPH for inclusion in the SIGGRAPH Video Review without receiving payment from ACM/SIGGRAPH.

30. After the 1982 SIGGRAPH Conference, in or around 1982, Digital submitted a Digtial 1982 Sampler to the SIGGRAPH Video Review.

31. AMC/SIGGRAPH included a Digital 1982 Sampler in Volume 5 of the SIGGRAPH Video Review, which review was produced in 1982.

32. Volumes 5 and 6 of the SIGGRAPH Video Review, in the VHS and BETA format, are contained on one tape. Volumes 5 and 6 of the SIGGRAPH Video Review in the 3/4" format are contained on separate tapes.

33. The Copy of Digital's 1982 Sampler included in the SIGGRAPH Video Review was followed by the closing credit "3. Japan Power, DVS." DVS refers to a corporation once solely owned and operated by Geshwind.

34. The Magic Egg is a compilation of computer animated film segments running approximately 15 minutes in length. The Magic Egg was produced in the Omnimax format and was intended for projection on a domed screen.

35. The concept for the Omnimax project was presented in the form of a letter to potential participants from Nelson Max dated December 7, 1982 (Plaintiff's Exh. 32) and subsequently in at least one meeting in Detroit at the same time as the 1983 annual SIGGRAPH conference in July by Max, Charles Henderson and Garrick.

36. The letter from Max solicited

contributions for a "SIGGRAPH Show Reel" illustrating the capabilities of computer graphics" and stated that "Presumably industrial sponsorship would generate and allow us to repay some of the costs from contributors. However, if this doesn't work out, I hope you are still willing to contribute to a SIGGRAPH show reel. If it is good enough, there is still a possibility of renting it to other Omnimax Theatres and generating income to pay back costs on some pro-rated basis."

37. On or about August 3, 1983 Garrick received a letter from Digital (Plaintiff's Exh. 18) which read: "Here are clips from the sequence Digtial hopes to produce for the Imax Film. They are the Times Square sequence and the Japanese Island. David Geshwind is functioning as producer."

38. On or about August 10, 1983 Garrick recived a letter from Geshwind

(Plaintiff's Exh. 17) concerning the possible inclusion of three pieces of computer graphics animation, including Japan Fly-by, in the Omnimax Film, which Geshwind stated he had produced.

39. In the latter part of 1983, Garrick met with Rosebush at Digital and discussed potential ideas for film contributions to the Omnimax Film from Digital.

40. Garrick and Digital ultimately agreed that Digital would submit to the Omnimax film product a segment of computer graphics animation.

41. Garrick provided a storyboard for a piece of computer graphics animation to Digital (Plaintiff's Exh. 16) containing the following description: "The gridwork of the city transforms into another gridwork - a topological map of a mountainous island. We have stopped our ascent and suddenly find ourselves poised

on the Peak of a Cosmic Rollercoaster. On either side of us are Huge Light Pipes which resemble fiber optic coils. They stretch into the distance converging on the topographic landscape below. The Light Pipes pulsate with bursts of energy as we Rollercoaster Down, lurching ahead on a speedride. After several exciting turns and dips, the path straightens out to a high and distant horizon before us and a Planet comes into view as we fade from the rollercoaster."

42. After receiving this storyboard description, Digital submitted a piece of computer graphics animation to the Omnimax film which was eventually entitled "Rollercoaster."

43. The Magic Egg consisted of approximately 20 segments of computer graphics animation.

44. In 1983, Productions signed an agreement with ACM/SIGGRAPH (Defendants'

Exh. G) whereby Productions loaned Garrick's services to SIGGRAPH to oversee the production and direction of a computer-animated Omnimax Film and to assist SIGGRAPH in "securing corporate financing for the production of the project" (1983 Agreement).

45. The 1983 Agreement provided that Productions would, for the term of twenty years, have the exclusive right to distribute the Omnimax film "through the Imax/Omnimax medium and form" and the non-exclusive right to distribute the Omnimax film in and through other mediums.

46. The 1983 Agreement set forth a formula by which any revenues generated from Productions' distribution of the Omnimax film would be distributed to Productions, ACM/SIGGRAPH and contributors.

47. On or about July 16, 1984,

Productions and ACM/SIGGRAPH each entered into a supplemental agreement with the Museum (1984 Agreements) whereby the Museum agreed to help finance the completion of the Project in return for certain distribution and exhibition rights (Defendants' Exhs. H and J).

48. The 1984 Agreements provided that the Museum would have the exclusive right to distribute the Omnimax film to science museums and related forums.

49. The 1984 Agreements provided that Productions would have the exclusive right to distribute the Omnimax film to entities other than science museums.

50. The 1984 Agreements set forth a formula by which any revenues generated from the licensing of the Omnimax film by the Museum to science museums would be distributed to the sponsors, Productions and contributors.

51. In or around August 1984,

Productions entered into license agreements with contributors to The Magic Egg which set forth a formula by which revenues generated by the film would be distributed.

52. A work print of The Magic Egg, including Rollercoaster, was exhibited at the Museum at certain screenings to conference attendees in conjunction with the 1984 SIGGRAPH conference in late or early August 1984.

53. The work print did not include credits, but credits for the film were displayed by slide projectors on the dome, which credits credited Roller-coaster to Digital and did not credit Geshwind.

54. Printed material was distributed to those who attended the VIP screenings of the film in conjunction with the 1984 SIGGRAPH Conference, which material included credits to contributors and

other participants in the film, crediting Rollerocaster to Digital and without crediting Geshwind.

55. Subsequent to the initial showings of The Magic Egg some articles were published about The Magic Egg in certain publications.

56. By letter dated August 20, 1984, from plaintiff's attorney, Anne C. Avellone, to the attorney for defendants Garrick and Productions, Robert Ungar, Avellone states that "Mr. Geshwind will not object if the workprint of the film continues to be shown in its initial run at the OMNIMAX theater in Minneapolis. However any exhibition of the finished work, or additional exhibition of the workprint, is objected to until a satisfactory solution to the problem is arranged."

57. Thereafter, in August 1984, Ungar on behalf of Productions requested

that Geshwind execute a license agreement (Defendants' Exh. Z) in connection with the use of Rollercoaster in The Magic Egg, in the exact same form which Productions requested each of the other contributors to the film to execute.

58. In a letter to Ungar sated August 30, 1984, Avellone wrote that "Mr. Geshwind has gone out of town for several days and will attend to the licensing agreement as soon as he returns."

59. In a letter to Ungar dated September 4, 1984, Avellone wrote that "with regard to the terms of the agreement itself, Mr. Geshwind will accept either a written guarantee that the agreement is identical to those signed by all of the other signatories or that a provision be included which provides that any advantage or additional right granted to any other signatory also be provided to him."

60. In a letter to Avellone dated September 7, 1984, Ungar stated: "Excepting the New York Institute of Technology, who has requested non-substantive changes in the license agreement, all licenses sent to contributors as the same. No other Contributor has asked for a guaranty."

61. Geshwind never signed a license agreement in connection with the Omnimax film.

62. In or around December 1984, Productions sued Geshwind in California for specific performance, declaratory relief and money damages in excess of $515,000 in connection with the proposed license agreement.

63. The Court in California did not find a basis on which to assert personal jurisdiction over Geshwind.

64. On or about September 12, 1984, Geshwind filed a registration application

for visual work, described as "a vector computer graphic computer simulation of flight over Japanese terrain following proposed power lines" entitled "Japan Fly-By" with the U.S. Copyright Office, which registration stated that he had produced, directed and designed computer animation and was the owner of the piece.

65. On or about September 12, 1984, the U.S. Copyright Office issued a Certificate of Copyright Registration (PA 228-127) for the work entitled Japan Fly-By to Geshwind.

The foregoing findings are almost identical to the parties' stipulated findings of fact. the Court makes the following additional findings of fact.

66. The storyboard for Japan Fly-By (Exh. D) comprised of a series of rough sketches showing scenes and describing the camera movement through those scenes to generate the overall effect was

distributed by Ruenitz to three persons for bids on the proposed project.

67. Geshwind delivered the storyboard to Digital before submitting his bid to Ruenitz and discussed various ways of producing the proposed animation with Digital's chief animator, Don Leich, as well as other Digital executives knowledgable in computer animation.

68. Three different techniques which might be utilized in the proposed film were discussed and cost estimates were provided by Digital to Geshwind, which he in turn utilized in making a tri-alternate proposal to Ruenitz. Ruenitz's client chose the least expensive alternative, a "wire-frame" method which had been recommended to Geshwind by Digital.

69. Geshwind then contracted with Digital to produce the computer film for him, which Digital agreed to do at a

fixed price. (Exhibit UUU).

70. Geshwind delivered to Leich a topographical map of Japan received from Ruenitz and a contour tracing of a smaller portion of the map.

71. Leich then, acting entirely without Geshwind, engaged in an extremely complex task of building preparatory data from the contour map of the northern half of Japan, coloring in elevations on the map, and then prepared a digitized tablet on which the elevations appeared raised. In this way, the simulated terrains of a distant and close-up area of Japanese topography were prepared.

72. Digital had created terrain in this manner before for another client.

73. Geshwind, who was not familiar with the software system used by Digital, had asked to view the terrains when created and had asked for an adjustment mechanism whereby elevations could be

changed.

74. Leich then prepared 5 or 6 sample frames of the terrain, utilizing advice of other Digital executives. Sample frames required the development of a data base of elevations, after an adapting of an elevation value system and rendering these results using the wire frame method and applying a light application to the wire mesh.

75. These sample frames were provided to Geshwind who in turn had them approved by Ruenitz's Japanese client.

76. Leich then worked on the flight path of the proposed Japan Fly-By, digitizing the anticipitated path over the detailed terrain by developing a series of T-frame (time frame) positions over the terrain.

77. Once the proposed T-frame positions were developed, Leich called Geshwind for meetings to review the

progress he was making, Geshwind would agree with the path contemplated by the storyboard or disagree and suggest changes.

78. After development of the proposed flight path was pretty much complete, Leich developed the motions of the film, generally by mathematical formulas which moved the camera focus up or down. However, a problem developed because the flight path was curved and this meant the effect of banking, similar to that of an airplane in flight, had to be simulated.

79. Geshwind was unhappy with the early motion simulation as developed by Leich and employed a Mr. Alexander to provide a mathematical formula to be utilized by the computer to improve the simulated banking. Alexander had previously provided this mathematical formula for banking simulation when

Geshwind had worked at the New York Institute of Technology in computer animation.

80. Geshwind only provided Alexander's formula to Leich verbally. Leich did not use the formula, but instead consulted another technician at Digital and used that technician's spline method, called CURVATURE, with an application called TILT, which had been previously used at Digital.

81. Geshwind viewed the result of Leich's application of the spline method and approved of the result, but was not made aware the Alexander formula had not been used.

82. Leich also developed the simulated power cable lines, which are somewhat transparent and flash light. Leich, a very credible, disinterested witness, testified that when Geshwind did review Leich's ongoing work product,

which he did nore often than those clients less knowledgable in computer graphics, he suggested general changes which Leich would make note of and then, after Geshwind had left, would take into consideration in his complex task of building the data base towards to the completion of the work. Geshwind who was not knowledgable in Digital's software system, was unable top draft specific computer instructions on that system.

83. Leich did not always follow Geshwind's suggestions. In addition to requesting the Alexander formula, which Leich did not adopt, Geshwind suggested continual changing of the lines to achieve a feeling of rapid approach. Leich, however used a change of resolutions method of quartering the white lines to achieve a seamless transition.

84. Geshwind disputes Leich's testimony, contending in effect that he

gave Leich minute instructions in every aspect of Japan Fly-By, to such an extent that it was his sole creation. Geshwind is a self-interested witness. The Court accepts Leich's testimony as true and rejects that of Geshwind where it differs.

85. Leich was also responsible for the creation of "Rollercoaster," for which he admits Digital used the data base from Japan Fly-By as a starting point to work on a somewhat similar storyboard supplied by Garrick.

86. Leich made numerous changes in the Japan Fly-By data base to make Rollercoaster, which also uses the "fly-by" effect. He omitted the first contoured terrain entirely and changed the second terrain by scaling down the elevations; he adjusted the flight path to make the transition over the hills differently; he changed the horizon line

and made the framing of the scenes lower; he changed the lighted tubes to make them more translucent; the motion of the camera is different, as is the rotation of the camera.

87. The Court has viewed both films on video and has viewed Rollercoaster in an IMAX theater and agrees with Leich that, although these is similarity in conception, there are significant differences in the two films.

CONCLUSIONS OF LAW

Section 201(a) of the Copyright Act provides, in pertinent part, that "[c]opyright in a work protected under these titles vests initially in the author or authors of the work." 17 U.S.C. §201(a) (1989). The Court concludes that Digital, through its employee Leich, was the creator of Japan Fly-by, both as a computer software data base and as a computer animated film.

The Court likens Mr. Leich to a painter who learned his techinques from other artists and teachers, and likens Mr. Geshwind to the agent for the person whose portrait was being painted. The fact that the agent Geshwind, wanted changes in details and aspects of the portrait and even made suggestions, the complience with which may or may not have improved the effect, does not make him the creator. The artist, Leich is the creator. See Whelan Associates Inc. v. Jaslow Dental Laboratory, Inc., 609 F. Supp. 1307 (E.D.Pa. 1985), aff'd, 797 F. 2d 1222 (3d Cir. 1986), cert. denied, 479 U.S. 1031, (1987) (under similar facts, court analogized to an owner explaining functions of a building to an architect, and concluded "[t]he architectural drawings are not co-authored by the owner, no matter how detailed the ideas and limitations expressed by the owner.") Here, Mr.

Leich worked for Digital as an employee. Accordingly Digital is the owner of Japan Fly-By and Rollercoaster. Therefore, under § 106 of the Copyright Act, Digital possessed the right to, inter alia, reproduce, distribute and display Japan Fly-By and plaintiff's claims under the Copyright and Lanham Acts are unfounded.

Alternatively, even if Digital is not the sole creator of Japan Fly-by, the work is a joint work of Digital and Plaintiff under § 101 of the Copyright Act.[1] See Community for Creative Non-Violence v. Reid, 846 F.2d 1485 (D.C.Cir 1988), aff'd ___ U.S. ___, 109 S.Ct.

1/ Section 101 defines joint work as follows:

> A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.
>
> 17 U.S.C. § 101 (1989).

2166, 104 L.Ed.2d 811 (1989); Strauss v. The Hearst Corp., No. 85 Civ. 10017, slip op., 1988 WL 18932 (S.D.N.Y. 1988). A joint owner of a work does not need the permission of his joint owner to use or license the work, and neither he nor a party to whom he gives permission to use the work can be held liable to the other owner for infringement. Strauss, supra.[2] Accordingly, since defendants acted with Digital's permission in including Japan Power in the SIGGRAPH Video Review and Rollercoaster in The Magic Egg, they are not liable to plaintiff.

During trial, plaintiff for the first time articulated a claim of "malicious prosecution" and abuse of

---

2/ While the joint owner who uses the work must account to the other owner for any profits which are received from its use, Reid, 486 F.2d at 1498, plaintiff has not made any claim against Digital.

process against Productions arising out of a suit Productions brought against plaintiff in California for breach of contract and breach of covenant of good faith and fair dealing.[3] This claim of malicious prosecution and abuse of process was expanded upon on page 49 of plaintiff's Post Trial Memorandum of Law and Facts which was filed five days after the Court-ordered submission date of March 16, 1990. The claim is rejected as not raised in a timely manner. Nevertheless, the Court will also address the merits of the claim.

Productions' suit in California against plaintiff was based upon plaintiff's failure to abide by, and misleading behavior in connection with, an

---

3/ Such an action was brought in the State of California and dismissed for failure to effect service on Geshwind.

alleged agreement in which Geshwind consented to the inclusion of the "Rollercoaster" segment in "The Magic Egg," and agreed upon the wording of the film credit for the segment. The alleged agreement had been negotiated between Productions' California attorney and Ms. Avellone, as plaintiff's attorney.

Plaintiff had attended the SIGGRAPH conference in July 1984 and protested to Mr. Garrick the inclusion of the "Rollercoaster" segment in the work print of "The Magic Egg," which was exhibited at the conference without any credit to him. In that conversation, plaintiff agreed to have his attorney try to resolve the matter with Productions' attorney. Plaintiff understood that production of the final version of "The Magic Egg" had to be completed in a couple of weeks. Nevertheless, plaintiff or Ms. Avellone waited approximately three weeks to first

contact Productions' attorney, which was done by letter. Thereafter, Mr. Avellone wrote a letter indicating agreement with the wording of the credit which had been worked out between plaintiff and Digital. Productions' attorney and Productions relied on Ms. Avellone's letter and her position as plaintiff's authorized representative, and left the "Rollerocaster" segment in the film. Work on the final editing of "The Magic Egg" proceeded on that basis. It is also unrebutted that thereafter plaintiff's counsel had a conversation with Productions' counsel in which she confirmed that the agreed upon wording would be in the film but in which she raised the question of reimbursement by Productions of her fees as counsel for the plaintiff. Productions' counsel responded with an inappropriate remark, which effectively ended further negotiation and caused plaintiff to disavow the

agreement.

As a result of the proceeding in reliance on Ms. Avellone's statements and conduct, Productions was now in a position where it had to remove the "Rollercoaster" segment from "The Magic Egg." Productions thereby incurred additional and unnecessary expense in re-editing the film, additional production costs, and time delays. Under these circumstances, the filing of the California lawsuit cannot be deemed malicious prosecution or abuse of process. Indeed, these was substantial reason to believe that plaintiff and his counsel sought to extract unwarranted consideration by withholding their written approval after Productions had relied on their statements and conduct. The Court concludes the California lawsuit had sufficient merit to be filed and cannot be deemed malicious prosecu-

tion or abuse of process, let alone unfair competition.

Judgment shall be entered for the defendants, with costs and attorneys' fees of the defendants and third-party defendants to be paid by plaintiff.

SO ORDERED.

Dated: New York, New York
April 12, 1990

Robert P. Patterson, Jr.
U.S.D.J.

UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK

DAVID M. GESHWIND,

Plaintiff,

v.

EDWARD GARRICK, Individually, EDWARD GARRICK PRODUCTIONS, INC., The SCIENCE MUSEUM OF MINNESOTA, and The ASSOCIATION FOR COMPUTING MACHINERY,

Defendants.

EDWARD GARRICK PRODUCTIONS, INC.,

Third Party Plaintiff,

v.

JUDSON ROSEBUSH and DIGITAL EFFECTS, INC.

Third Party Defendants

FILE NO.: 85 CIV. 2136 (RPP)

ENTERED: JUNE 16, 1990

OPINION AND ORDER

ROBERT P. PATTERSON, JR., DISTRICT JUDGE.

In a Decision dated April 12, 1990 as amended April 16, 1990, this Court

ordered that judgment be entered for the defendants, with costs and attorneys' fees of the defendants and third-party defendants to be paid by plaintiff. Plaintiff now moves for an order vacating and setting aside the Court's findings of fact and conclusions of law and granting a new trial, and, in a separate motion, for an order vacating the award of costs and attorneys fees.[1]

1. Plaintiff's Motion For A New Trial

Although not specified in the motion papers, the Court will treat Plaintiff's motion for a new trial as a motion made under Fed.R.Civ.P. 59. Defendants argue that the motion should be denied because

---

1/ Plaintiff's motion for a new trial was made returnable on May 15, 1990, but was not received in chambers until May 17, 1990. Plaintiff's motion to vacate the award of costs and attorneys' fees was made returnable on May 26, 1990 but was not received in chambers until May 24, 1990.

it is untimely and without merit. For the reasons stated in my memorandum order of May 18, 1990, the motion is deemed timely. For the reasons noted below, however, the motion is found to be without merit.

"Three grounds have been recognized in non-jury cases as a basis for granting a new trial: (1) manifest errors of law, (2) manifest errors of fact and (3) newly discovered evidence." Agola v. Hagner, 678 F.Supp. 988, 991 (E.D.N.Y. 1987). Accord Rosera v. International Harvester Co., 109 F.R.D. 143, 149 (E.D. Wis, 1986); Bell Telephone Laboratories Inc. v. Hughes Aircraft Co., 73 F.R.D. 16, 20 (D.Del 1976), aff'd, 564 F.2d 654 (3rd Cir. 1977), cert denied, 435 U.S. 924 98 S.Ct 1289, 55 L.Ed.2d 518 (1978); 6A Moore's Federal Practice ¶ 59.07, p. 59-72 (1989). Plaintiff has failed to show adequate support for any of these three

grounds and accordingly is not entitled to a new trial.

Plaintiff argues that he did not receive a fair trial because the Court denied his motion for a two-month continuance. This case was five years old at the time, and plaintiff was given notice on January 3, 1990 that the case was being placed in the Court's trial calendar on February 20, 1990, at which time it could proceed on 48 hours notice. A final pre-trial conference was held on February 20, 1990 and the trial commenced on February 23, 1990. This constitutes more than adequate notice [2] accordingly, there is no basis for plaintiff's claim

---

2/ The Court's trial calendar has been virtually up to date in the spring of 1990. Trials cannot be adjourned for the convenience of the litigants if the Court is to keep its trial part busy on a full time basis and thus afford prompt trials to all cases which require resolution by a trial.

that he had insufficient time to prepare for trial.

Plaintiff also claims that he was unfairly precluded from offering expert witnesses. However, the court directed the attorneys on January 3, 1990 to provide expert reports to their adversaries by February 1, 1990. Plaintiff did not comply. At the final pre-trial conference on February 20, 1990 the Court nonetheless granted plaintiff's attorney a continuance until the next day to supply those reports. The document produced the next day was wholly inadequate as an expert's report and the Court therefore determined that to allow plaintiff's experts to testify would be unfairly prejudicial to defendants.

Finally, plaintiff argues that the Court erred in its findings of fact. None of the issues raised by plaintiff, however, were overlooked by the Court.

Plaintiff simlpy disagrees with the Court's findings rather than pointing to "manifest errors of fact." There is therefore no basis for granting a new trial. Rather than relitigate matters already considered by this Court, plaintiff should address his arguments to the Court of Appeals for the Second Circuit.

Accordingly, plaintiff's motion for a new trial is denied.

2. The Motion To Vacate the Award of Costs and Attorney's Fees

Although 17 U.S.C. § 505 expressly permits "a reasonable attorney's fee to the prevailing party as part of the costs," the Second Circuit has limited the circumstances under which it is appropriate to award attorneys' fees to a prevailing defendant. Thus, defendants should only receive attorney's fees when the plaintiff's claim is "objectively without arguable merit." Diamond v. Am-

Law Publishing Corp., 745 F.2d 142, 148 (2d Cir. 1984). In awarding defendants attorney's fees in the present case, the Court was not provided with case law and did not consider this interpretation of Section 505 by the Court of Appeals. It does so now for the first time.

For several reasons, the Court is unable to say that plaintiff's claim in this case was "objectively without arguable merit." While ultimately determined to be unfounded, the claim was colorable at the time it originally was brought. As plaintiff points out, the Court's decision on the merits was based in large part on two cases, Community for Creative Non-Violence v. Reid, 846 F.2d 1485 (D.C. Cir. 1988) aff'd ___ U.S. ___, 109 S.Ct 2166, 104 L.Ed2d 811 (1989) and Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc., 609 F. Supp. 1307 (E.D. Pa. 1985), aff'd, 797 F.2d 1222 (3d Cir.

1986), cert. denied, 479 U.S. 1031, 107 S.Ct 877, 93 L.Ed.2d 831 (1987), both of which were decided after plaintiff's action was commenced. The Supreme Court's discussion in the Reid case, in particular, clarified prior decisions with respect to the scope of "work for hire" as defined in the Copyright Law of 1976. Plaintiff's claim to the artistic work in question is found to be colorable under the law as it existed prior to that decision. In light of these circumstances, it would be inappropriate to award attorney's fees to defendants for the period prior to the Supreme Court's decision in Reid. The total amount of fees requested gives added support to this determination.

Since plaintiff did elect to proceed to trial after these cases adverse to his position were reported, there remains the question of the substantial fees incurred

by defendants subsequent to Reid and Whelan. It is debatable whether an attorney who objectively evaluated plaintiff's claim at that time would have concluded that the case had merit and should be brought to trial. While this Court is reluctant, in most circumstances, to question the objectivity of an attorney, it appears that the personal relationship between plaintiff and his attorney may have clouded the attorney's judgment.

The problem of lack of objectivity is well-known in the legal profession, and gave rise to the ancient lawyer's adage "a lawyer who represents himself has a fool for a client." An attorney who represents a close relative, or some other person in wh m the attorney has an emotional or personal stake, is similarly in a poor position to make an objective determination of the likelihood of pre-

vailing. The Court is inclined to adhere to its practice of giving attorneys admitted to the bar of this Court the benefit of the doubt. On the other hand, counsel's close identification with plaintiff undoubtedly influenced her decision to bring this case to trial, and to that extent contributed to defendants' substantial legal expenses. Although these countervailing factors are difficult to balance, it is determined that plaintiff's claim was not "objectively without arguable merit," and that plaintiff's counsel was able to make a good faith presentation of plaintiff's claim.

Accordingly, plaintiff's motion to vacate the award of attorney's fees and costs is granted.

3. Conclusion

Plaintiff's motion for a new trial is denied, and plaintiff's motion to vacate the award of attorney's fees and

costs is granted.

SO ORDERED.

Date: New York, New York
June 16, 1990

Robert P. Patterson, Jr.
U.S.D.J.

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, in the City of New York, on the eleventh day of February, one thousand nine-hundred and ninety-one.

Present:

Hon. Wilfred Feinberg,
Hon. William H. Timbers,
Hon. Jon O. Newman,

Circuit Judge

GESHWIND

v.

GARRICK

DOCKET NO. 90-7560

ENTERED: FEBRUARY 11, 1991

A petition for rehearing having been filed herein by David M. Geshwind, Pro Se.

Upon consideration by the panel that decided the appeal, it is DENIED.

Ordered that said petition be and it hereby is DENIED.

Elaine B. Goldsmith,
Clerk

No. 90-1759

Supreme Court, U.S.
FILED
JUN 19 1991
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

DAVID M. GESHWIND,

Petitioner,

—v.—

EDWARD GARRICK, Individually, EDWARD GARRICK PRODUCTIONS, INC., The SCIENCE MUSEUM OF MINNESOTA, and The ASSOCIATION FOR COMPUTING MACHINERY,

Respondents.

EDWARD GARRICK PRODUCTIONS, INC.,

Third-Party Plaintiff,

—v.—

JUDSON ROSEBUSH and DIGITAL EFFECTS, INC.,

Third-Party Defendants.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

SLADE R. METCALF
(Counsel of Record)
MARK H. JACKSON
SQUADRON, ELLENOFF, PLESENT & LEHRER
Attorneys for Respondents
551 Fifth Avenue
New York, New York 10176
(212) 661-6500

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

STATEMENT OF THE CASE 1

SUMMARY OF THE ARGUMENT 6

ARGUMENT 8

I. PETITIONER HAS FAILED TO SET FORTH A SUFFICIENT BASIS FOR THIS COURT TO GRANT HIS PETITION FOR A WRIT OF CERTIORARI 8

II. THE COURTS BELOW CORRECTLY HELD THAT DIGITAL EFFECTS, INC., AND NOT PETITIONER, WAS THE SOLE CREATOR OF JAPAN FLY-BY 12

III. THE COURTS BELOW PROPERLY CONSIDERED THE ISSUE OF COPYRIGHT OWNERSHIP 17

CONCLUSION 24

TABLE OF AUTHORITIES

CASES

Berenyi v. District Director, Immigration and Naturalization Service,
385 U.S. 630 (1967) 10

Bradford Trust Company of Boston v. Merrill Lynch, Pierce, Fenner and Smith, Inc.,
805 F.2d 49 (2d Cir. 1986) 21-22

Branti v. Finkel,
445 U.S. 507 (1980) 9

Broadcast Music Inc. v. CBS Inc.,
Copyright L. Rep. (CCH)
¶ 25,556 (S.D.N.Y. 1983) 18

Bucky v. Sebo,
208 F.2d 304 (2d Cir. 1953) 21

Community for Creative Non-Violence v. Reid,
490 U.S. 730 (1989) . . . 6, 7, 12, 14, 15

Eden Toys, Inc. v. Florelee Undergarment Co. Inc.,
697 F.2d 27 (2d Cir. 1982) 18

Geshwind v. Garrick,
734 F. Supp. 644 (S.D.N.Y. 1990) 1

Geshwind v. Garrick,
738 F. Supp. 792 (S.D.N.Y. 1990) 1

Jones v. CBS, Inc.,
733 F. Supp. 748 (S.D.N.Y. 1990) . . . 22

TABLE OF AUTHORITIES

CASES (continued)

Neil v. Biggers,
409 U.S. 188 (1972) 10

Reyher v. Children's Television Workshop,
533 F.2d 87 (2d Cir. 1976),
cert. denied, 429 U.S. 980 (1976) . . . 22

United States v. Nobles,
422 U.S. 225 (1975) 10

STATUTES, RULES AND TREATIES

Rule 10, Rules of the Supreme Court of the
United States 6

United States Copyright Act of 1976,
17 U.S.C. § 101 et. seq. (1977) . . *passim*

STATEMENT OF THE CASE[1]

Rather than repeat all the facts established during the ten day trial of this matter, Respondents respectfully refer this Court to the findings of fact of United States District Court Judge Robert P. Patterson as set forth in Findings of Fact, Conclusions of Law and Decision dated April 12, 1990 ("Decision") (The Decision is included in the Appendix to Petition, pp. 7-33 and is published at 734 F. Supp. 644 (S.D.N.Y. 1990) and 738 F. Supp. 792 (S.D.N.Y. 1990). Respondents will also not attempt to correct all of the mischaracterizations contained in Petitioner's Statement of the Case, but will confine themselves to correcting certain egregious errors.

---

[1] Pursuant to Rule 29.1 of the Rules of the Supreme Court of the United States, Respondents hereby advise the Court that none of them have corporate parents or subsidiaries.

First, Petitioner completely mischaracterizes the role of Donald Leich ("Leich"), an employee of Digital Effects, Inc. ("DEI"), in creating Japan Fly-By. Leich testified at trial that although Petitioner provided DEI with the storyboard created by Tohoku Electric Power Company, the ultimate client, and a commercial map of Japan, as well as some general suggestions during certain stages of production, it was Leich who took the general concept of a pair of power lines travelling through mountainous terrain and transformed it into a computer animation. (Tr. 1119).[2] In his Decision, Judge Patterson made the following factual determination:

> Geshwind disputes Leich's testimony, contending in effect that he gave Leich minute instructions in every aspect of Japan Fly-By, to such an extent that it was his sole creation. Geshwind is a self-interested witness.

---

[2] References preceded by "Tr." refer to the transcripts of the trial of this matter.

> The Court accepts Leich's testimony as true and rejects that of Geshwind where it differs.

(Appendix to Petition, pp. 30-31). The Court of Appeals affirmed the Decision based on the opinion below. (Appendix to Petition, pp. 1-4). Petitioner has again chosen to exaggerate his role in the creation of Japan Fly-By to this Court.

Petitioner also falsely claims that DEI did not assert its ownership interest in Japan Fly-By until the trial. In fact, in his affidavit in support of Respondents' Motion for Summary Judgment, filed almost three years prior to the trial, Leich made clear that he considered DEI the author of the work:

> Geshwind provided DEI with a storyboard depicting the desired sequence, as well as topographic maps of Japan which would be used in designing the segment. It was DEI's job to take this general concept and produce an animated computer graphic

> which would meet Geshwind's and his Japanese client's needs.

(A-384).[3]

Finally, Petitioner mischaracterizes the way in which he received credit for the segment entitled "Rollercoaster" in early versions of the Omnimax film entitled "The Magic Egg." Petitioner implies that DEI and the producer of The Magic Egg, Edward Garrick ("Garrick"), decided to credit Petitioner as the 'creator' of the segment on their own, unrelated to the claims asserted by Petitioner. In fact, DEI and Garrick agreed to provide credit to Petitioner as an accommodation to Petitioner in an attempt to resolve the dispute. (Appendix to Petition, pp. 37-40). Indeed, in his Decision, Judge Patterson determined that after

---

[3] References preceded by "A-" refer to those parts of the record included in the appendix filed by Petitioner with the Court of Appeals.

agreeing to the wording of the credit for Rollercoaster in settlement of Petitioner's claim, and after Garrick included the segment in The Magic Egg in reliance on such agreement, Petitioner's counsel improperly attempted to extract additional concessions from Garrick. (Appendix to Petition, p. 39).

SUMMARY OF THE ARGUMENT

The issues raised by this Petition For A Writ of Certiorari ("Petition") do not constitute "special and important reasons" for this Court to grant certiorari within the meaning of Rule 10 of the Rules of the Supreme Court of the United States. The first issue raised by Petitioner merely relates to an application of the facts of this case to the work made for hire provisions of the Copyright Act, as interpreted by this Court in Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) ("CCNV"). The second issue relates to a procedural determination clearly within the discretion of the District Court.

In any event, there is no merit to either of Petitioner's claims. The Courts below were not required to analyze whether DEI or Leich was Petitioner's "employee" when such a finding was not even remotely suggested by the evidence and the

claim was never made by Petitioner to the District Court. Moreover, under this Court's analysis in CCNV, there is no basis for Petitioner's claim.

Petitioner cannot claim that he was unfairly prejudiced by Respondents' introduction of evidence demonstrating that DEI owned the copyright to Japan Fly-By when Petitioner never objected to the introduction of such evidence, and in fact, elicited such testimony himself.

ARGUMENT

I

PETITIONER HAS FAILED TO SET FORTH A SUFFICIENT BASIS FOR THIS COURT TO GRANT HIS PETITION FOR A WRIT OF CERTIORARI

Rule 10 of the Rules of the Supreme Court of the United States ("Supreme Court Rules") expressly provides that "[A] petition for a writ of certiorari will be granted only when there are special and important reasons therefor." The Rule provides that such reasons must be of a similar character to, among other things, (1) a conflict among the circuits on the same matter; (2) a decision by a court of appeals deciding a federal question in a way that conflicts with a state court of last resort; or (3) a departure by a court of appeals "from the accepted and usual course of judicial proceedings," or its sanctioning "such a departure by a lower court, as to call for an

exercise of [the Supreme Court's] power of supervision." Supreme Court Rules, Rule 10.

It is clear that even if Petitioner's claims had merit, which Respondents deny, Petitioner here has not presented any issue of the magnitude required by Rule 10.

The first issue raised by Petitioner -- whether the District Court improperly failed to apply the work made for hire analysis to Petitioner's relationship with DEI -- is merely an attempt by Petitioner to reargue for the third time his disagreement with the District Court's determination, affirmed by the Court of Appeals, that DEI, and not Petitioner, owns the copyright in Japan Fly-By. Petitioner has absolutely no basis for seeking this Court's review of that determination. See Branti v. Finkel, 445 U.S. 507, 512 n. 6 (1980) (reaffirming this Court's "settled practice of accepting, absent the most exceptional circumstances, factual determinations in which the

district court and the court of appeals have concurred"); Neil v. Biggers, 409 U.S. 188, 193, n. 3 (1972) (noting that the "rule of practice, under which the Court does not lightly overturn the concurrent findings of fact of two lower federal courts, is a salutary one to be followed where applicable"); Berenyi v. District Director, Immigration and Naturalization Service, 385 U.S. 630, 635-36 (1967) (to same effect).

The second issue raised by Petitioner -- that the District Court improperly permitted Respondents to raise an issue at trial that was not set forth in the Pre-Trial Order -- is clearly an issue that is within the District Court's discretion. The District Court was in the best position to determine whether Petitioner would be unfairly prejudiced by the introduction of particular evidence. See United States v. Nobles, 422 U.S. 225, 241, n. 16 (1975) (holding that the Court would not review a District Court's evidentiary

rulings "in the absence of a strong suggestion of an abuse of [] discretion or an indication that the issues are of sufficient general importance to justify the grant of certiorari . . ."). It is clear from the face of the Petition here that Petitioner's claim is not of "sufficient general importance" to merit the granting of certiorari by this Court. In any event, it is evident from the discussion in Point III, infra, that the District Court, and the Court of Appeals, had good reason for finding that Petitioner suffered absolutely no prejudice from the introduction of testimony challenging his ownership in the copyright to Japan Fly-By.

Accordingly, Respondents respectfully request that this Court deny this Petition.

II

THE COURTS BELOW CORRECTLY HELD THAT DIGITAL EFFECTS, INC., AND NOT PETITIONER, WAS THE SOLE CREATOR OF JAPAN FLY-BY

Section 201(a) of the Copyright Act provides, in pertinent part, that the "[c]opyright in a work protected under this title vests initially in the author or authors of the work." 17 U.S.C. § 201(a) (1989). As this Court noted in CCNV, 490 U.S. at 737: "[A]s a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection."

In the instant case, the District Court, after a painstaking review of the process involved in creating "Japan Fly-By," ruled that DEI, through the creative efforts of its employee Leich, was the sole author of the work, and therefore owned the copyright. (Appendix to Petition, p. 32). In reaching that decision, the District Court

expressly credited the testimony of Leich over that of Petitioner. (Id. at 30). The Court of Appeals affirmed this finding, without opinion, "substantially for the reasons" given by the District Court.

Petitioner's argument that the District Court failed to consider whether DEI was an "employee" of his under § 101 of the Copyright Act makes no sense. There was absolutely no reason for the Court to include in its Decision an analysis of whether DEI created Japan Fly-By as an "employee" of Petitioner because such an idea is illogical. In fact, Petitioner never made such a claim to the District Court either during the trial or in post-trial memoranda.

Even if this Court were to apply the work made for hire analysis to Petitioner's new theory, it is obvious that neither DEI nor Leich was Petitioner's employee. Section 101 of the Copyright Act provides that a work is "for hire" if

it is "prepared by an employee within the scope of his or her employment."[4]

In CCNV, this Court ruled that agency principles should be applied to determine, under § 101(1) of the Copyright Act, whether a commissioning party is entitled to be considered an author for copyright purposes under the work made for hire doctrine. Id. at 751-52. This Court considered such factors as: (1) the hiring party's right to control the manner and means by which the product is accomplished; (2) the skill required by the hired party; (3) the location of the work; (4) whether the hiring party has the right to assign additional projects to the hired party; (5) the method of payment; and (6) the provision of employee benefits. Id. at 751-52.

---

[4] Subsection (2) of the § 101 definition cannot possibly have application here since it is undisputed that there is no written document evidencing a specific intention to make Japan Fly-By as a "work made for hire."

It is clear under this Court's analysis in CCNV that neither DEI nor Leich was Petitioner's employee under the work made for hire doctrine. First, it cannot seriously be maintained that Petitioner was the employer of DEI, a corporate entity; nor can Petitioner realistically contend that he was Leich's employer when it is undisputed that Leich was an employee of DEI. But even if one applies the principles of agency here, it is clear that Petitioner was not the employer of either DEI or Leich. Although Petitioner provided certain direction during the course of production, Petitioner did not even provide the initial concept for the piece. It is undisputed that the storyboard came from Japan. (A-176). The remaining factors make it clear that DEI and Leich were operating as independent contractors. It is undisputed that Leich, and everyone else employed by DEI, were highly trained and creative people, that all of the production work for Japan Fly-By

took place at DEI's offices, using DEI computers, subroutines and staff (Tr. 1090; A-269), that Petitioner clearly had no right to assign additional projects to DEI or Leich without entering into a separate contract, that the method by which Petitioner paid DEI was consistent with the compensation of independent contractors (Ex. 94)[5], and that Petitioner did not provide employee benefits to DEI or Leich.

It is clear from the foregoing that there was no reason for the Courts below to analyze the work made for hire doctrine with respect to the relationship between Petitioner and DEI. In any event, there is no basis for Petitioner's claim that he was the owner of the copyright to Japan Fly-By by virtue of the work made for hire doctrine.

---

[5] References preceded by "Ex." refer to the exhibits included in the Exhibit binder filed by Petitioner with the Court of Appeals.

III

THE COURTS BELOW PROPERLY CONSIDERED THE ISSUE OF COPYRIGHT OWNERSHIP

Petitioner claims that he was prejudiced by the District Court's willingness to hear testimony regarding the claim that DEI, and not Petitioner, was the copyright owner of Japan Fly-By. Petitioner argues that Respondents did not include this issue in the Pre-Trial Order, and therefore, the Courts below should not have considered the issue and dismissed Petitioner's copyright claim on the basis that DEI was the owner of the subject copyright. There is no merit to Petitioner's claim.

First, the Pre-Trial Order did set forth disputed issues of law which covered the question of whether or not Petitioner owned the copyright in Japan Fly-By. The first and second issues contained in Defendants' Statement of Issues of Law read:

> (1) Whether Geshwind has standing to assert a claim under the Copyright Act for an allegedly unauthorized commercial use of "Japan Fly-By"?
>
> (2) Whether plaintiff is the legal or beneficial owner of the exclusive right to promote "Japan Fly-By" commercially in order to give him standing to assert his claim under the Copyright Act for an allegedly unauthorized commercial use of "Japan Fly-By"? See 17 U.S.C. § 501(b); Eden Toys, Inc. v. Florelee Undergarment Co. Inc., 697 F.2d 27 (2d Cir. 1982); Broadcast Music Inc. v. CBS Inc., Copyright L. Rep. (CCH) ¶ 25,556 (S.D.N.Y. 1983).

(A-249-50). There is, therefore, no factual basis for Petitioner's claim.

In any event, Petitioner cannot possibly show that he was prejudiced by the introduction of evidence challenging his ownership of the copyright in Japan Fly-By. The record is clear that Petitioner did not object to testimony related to the ownership of the copyright, nor did he object to testimony claiming that DEI was the owner. Petitioner only raised this issue on appeal in a

desperate attempt to find an issue upon which to challenge the Decision. In fact, at one point during the trial, Judge Patterson specifically alerted Petitioner's counsel, Anthony Handal, to the fact that DEI claimed ownership in the piece and Petitioner's counsel acknowledged that fact:

> THE COURT: You were conferring with Ms. Avellone [Petitioner's co-counsel] while I was asking those questions. You understand that the witness is assuming that his shop was the creator?
>
> MR. HANDAL: Yes, Your Honor.
>
> THE COURT: And that all they did was complete, after creating the product, sold the film to Mr. Geshwind for ultimate sale to Ruenitz. That's what he is assuming.
>
> MR. HANDAL: Let me ask the witness one further question.
>
> THE COURT: He's not accepting Mr. Geshwind's testimony at all. I just want to be sure you understand that's what he's doing when he answered my questions.

(Tr. 1104-05).

In fact, it was Petitioner who first put DEI's role in creating Japan Fly-By in issue. Petitioner called DEI's former president, Judson Rosebush, as his first witness on his main case and elicited testimony about DEI's knowledge of and experience with computer animation and its role in the creation of Japan Fly-By. (Tr. 145-78, 259-62, 274, 301-08).[6] Thereafter, Petitioner devoted practically all of his case to proving that he contributed enough to the work to be considered the author, and that DEI and Leich were engaged in only the mechanical aspects of creating the piece. (Tr. 380-428, 690-94, 1281-1301). Accordingly, Petitioner clearly waived any right he may have had to object to the introduction of this testimony.

---

[6] During Petitioner's examination of Rosebush, the issue of which party owned the database and video display to Japan Fly-By was expressly raised and discussed with the Court. (Tr. 231-38, 293-96, 300-01, 1094-1105, 1113-14).

Courts have repeatedly held that parties cannot claim surprise or prejudice when a court rules on an issue which was not contained in a Pre-Trial Order where evidence relating to that issue was introduced at trial and the complaining party did not raise an objection. Bradford Trust Company of Boston v. Merrill Lynch, Pierce, Fenner and Smith, Inc., 805 F.2d 49, 53-54 (2d Cir. 1986) (where the issue of forgery was raised several times and described as the "key" issue during the short bench trial without objection by plaintiff, trial court did not abuse its discretion in denying post-trial motion to modify the pre-trial order or to reopen the case to permit appellant to submit evidence already available to it); Bucky v. Sebo, 208 F.2d 304 (2d Cir. 1953) ("[A]s plaintiff's counsel during the trial made at least a brief reference to the issue. . . and as defendant's counsel did not then object or ask an adjournment, we think that the trial judge was at liberty to

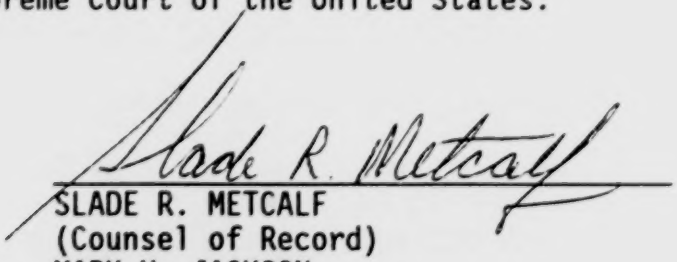
consider that issue. . ."). Accordingly, there is no merit to Petitioner's claim that he was unfairly prejudiced.

In addition, it has been established that a party cannot claim that it was surprised or prejudiced by the admission of evidence on a certain issue when that issue constitutes an element of the party's case. Bradford, 805 F.2d at 53 (although it was "a close question" whether the issue of forgery was listed as a disputed legal issue in the Pre-Trial Order, "[n]onetheless, [ ] plaintiff was obligated to present its case and to prove the elements of its cause of action."). Since it was Petitioner's burden as plaintiff to prove that he owned the copyright by virtue of his "authorship," Reyher v. Children's Television Workshop, 533 F.2d 87, 90 (2d Cir. 1976), cert. denied, 429 U.S. 980 (1976); Jones v. CBS, Inc., 733 F. Supp. 748 (S.D.N.Y. 1990), he cannot now claim that he was prejudiced by Respondents'

introduction of evidence challenging his authorship.

CONCLUSION

WHEREFORE, Respondents respectfully request that this Court deny the Petition For A Writ of Certiorari and grant any such further relief as this Court deems just and proper, including damages and double costs pursuant to Rule 42 of the Rules of the Supreme Court of the United States.



SLADE R. METCALF
(Counsel of Record)
MARK H. JACKSON
SQUADRON, ELLENOFF, PLESENT & LEHRER
Attorneys for Respondents
551 Fifth Avenue
New York, New York 10176
(212) 661-6500